

REMARKS

Applicant respectfully requests reconsideration of this application as amended.

Claims 1-22 and 26-38 are pending in this application.

Claims 1-10, 18-28 and 34-38 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter, or otherwise lacking patentable utility.

Claims 1-38 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as his invention.

Claims 1-38 were provisionally rejected as being unpatentable over co-pending Application No. 09/865,557 under the judicially created doctrine of obviousness-type double patenting.

Claims 1-6, 8, 11-27, 29-32, 34 and 36-38 were rejected under 35 U.S.C. §102(e) as being considered anticipated by U.S. Patent Application Publication 2003/0046421 of a patent application filed by Horvitz et al (hereinafter referred to as "Horvitz").

Claims 7-10, 28, 33 and 35 were rejected under 35 U.S.C. §103(a) as being considered unpatentable over Horvitz, in view of well known prior art.

Claims 23-25 have been cancelled.

Claims 1-22 and 29-36 have been amended.

No claims have been added.

35 U.S.C. §101 Rejection of Claims 1-10, 18-28 and 34-38

The Examiner has rejected claims 1-10, 18-28 and 34-38 under 35 U.S.C. §101 as being directed non-statutory subject matter or otherwise lacking patentability. Specifically, the Examiner has asserted that claims 1-10 and 18-28 recite a method that does not require any form of computer hardware or software to complete the task recited therein, and can therefore, be accomplished by a person with pen or pencil on paper. The Examiner has asserted that claims 34-38 suffer analogous deficiencies.

Applicant thanks the Examiner for drawing Applicant's attention to this matter, and Applicant has amended independent claims 1, 18, 34 and 36 from which claims 2-10, 19-28, 35 and 37-38, respectively, depend to address this shortcoming by more distinctly reciting the limitations requiring more than what can be accomplished by a person with pen or pencil on paper. What is recited by these claims should now properly comport with what is deemed to be patentable subject matter under *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998), and as further clarified within section 2106 of the 2nd revision of the 8th edition of the MPEP.

35 U.S.C. § 112 Rejection of Claims 1-38

The Examiner has rejected claims 6 and 16 under 112 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has rejected claims 1, 11, 18, 29, 34 and 36 for reciting the limitation "the level" without sufficient antecedent basis. The Examiner has rejected claims 1, 11, 18 and 34 for reciting the limitation "a level of importance" as not being clear as to whether or not multiple instances of this limitation all refer to the same "level of importance" or not. The Examiner has rejected claim

7 for reciting the limitation "a GPS receiver within the device" without sufficient antecedent basis. The Examiner has rejected claims 29 and 36 for reciting the limitation "a level of importance" as not being clear as to whether or not multiple instances of this limitation all refer to the same "level of importance" or not. The Examiner has rejected claims 34 and 36 for reciting the limitation "a first person" as not being clear as to whether or not multiple instances of this limitation all refer to the same "first person" or not. The Examiner has further asserted that all dependent claims suffer analogous deficiencies.

Applicant thanks the Examiner for drawing Applicant's attention to this matter, and Applicant has amended claims 1-9, 11-22, 29-34 and 36 to address these deficiencies, as well as to address other instances of vague language in the claims not cited by the Examiner as the Examiner has instructed.

Provisional Obviousness-Type Double Patenting Rejection of Claims 1-38

The Examiner has provisionally rejected claims 1-38 as being unpatentable over co-pending Application No. 09/865,557, under the judicially created doctrine of obviousness-type double patenting based on a policy of preventing unjustified or improper timewise extension of the "right to exclude" and possible harassment of others by multiple assignees. As suggested by the Examiner, Applicant has provided a terminal disclaimer, herewith, to overcome this rejection.

35 U.S.C. §102(e) Rejection of Claims 1-6, 8, 11-27, 29-32, 34 and 36-38

The Examiner has rejected claims 1-6, 8, 11-27, 29-32, 34 and 36-38 under 35 U.S.C. §102(e) as being considered to be anticipated by Horvitz. Applicant has cancelled claims 23-25, thereby obviating this rejection with regard to these claims. Still, Applicant respectfully submits that none of claims 1-6, 8, 11-27, 29-

32, 34 and 36-38 are not anticipated by Horvitz, because Horvitz does not teach each and every element of Applicant's invention as claimed.

Regarding independent claims 1, 11 and 34, the Examiner has asserted that Horvitz discloses selecting a plurality of persons to contact and attempting to contact the plurality of persons if the level of importance of an event greater than or equal to a second predetermined threshold. However, Applicant respectfully submits that Horvitz does not disclose any instance of making any form of selection of which person or persons to contact depending on a level of importance of an event. A reading of Horvitz reveals that Horvitz teaches only trying to contact the user. For at least these reasons, Applicant respectfully submits that claims 1, 11 and 34 are patentably distinguished over Horvitz.

Regarding independent claims 18, 29 and 36, and dependent claim 25, the Examiner has asserted that Horvitz discloses learning that a sent message failed to reach a user, because he or she is away from the client device and redirecting the message to another specified device. Applicant respectfully submits that Horvitz does not disclose the limitations of claim 25, specifically, an instance of making a choice between resending a message to a user via another device and sending a message to another person, depending on the nature of the failure. Again, a reading of Horvitz reveals that Horvitz teaches only trying to contact the user. Applicant has cancelled claim 25, and incorporated the limitations of claim 25 into independent claims 18, 29 and 36. For at least these reasons, Applicant respectfully submits that claims 18, 29 and 36 are patentably distinguished over Horvitz.

Regarding claims 2-6, 12-17, 19-24, 26-27, 30-32, and 37, these claims depend variously from independent claims 1, 11, 18, 29, 34 and 36, which Applicant has previously asserted are patentably distinguished over Horvitz.

Regarding claim 8 Applicant notes that although this claim was included in the list of those rejected as anticipated by Horvitz, there is no specific information provided as to the exact nature of the rejection of this claim. Regardless, claim 8 depends from independent claim 1, which Applicant has previously asserted is patentably distinguished over Horvitz.

Regarding claim 38, despite the assertion in the Office Action that Horvitz discloses taking action without contacting any person, a reading of Horvitz reveals no disclosure of a digital assistant taking action without contacting anyone. For at least these reasons, and for the reason that claim 38 depends from independent claim 36, Applicant respectfully submits that claim 36 is patentably distinguished over Horvitz.

In view of the foregoing arguments, Applicant respectfully asserts that claims 1-6, 8, 11-22, 26-27, 29-32, 34 and 36-38 are in condition for allowance.

35 U.S.C. § 103(a) Rejection of Claims 7-10, 28, 33 and 35

The Examiner has rejected claims 7-10, 28, 33 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Horvitz, in view of well known prior art.

Regarding claims 7, 9-10, 28, 33 and 35, these claims depend from independent claim 1, which Applicant has previously asserted are patentably distinguished over Horvitz.

Regarding claim 8 Applicant notes that although this claim was included in the list of those rejected as unpatentable over Horvitz in view of well known prior art, there is no specific information provided as to the exact nature of the rejection of this claim. Regardless, claim 8 depends from independent claim 1, which Applicant has previously asserted is patentably distinguished over Horvitz.

In view of the foregoing arguments, Applicant respectfully asserts that claims 7-10, 28, 33 and 35 are in condition for allowance.

Condition for Allowance

Applicant submits that all rejections have been overcome and the present application is now in condition for allowance. If there are any additional charges or shortages related to the present communication, please charge our Deposit Account No. 50-0221.

Respectfully submitted,
Benjamin D. Burge

Dated: 9/9/04

Benjamin D. Burge

Attorney for Applicant
Registration No.: 42372